

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

Claims 1-17 were pending in this application. Claims 14 and 16-17 have been cancelled and claims 1 and 15 have been amended hereby. Support for the amendment to claim 1 can be found in now-cancelled claim 14.

In the Office Action claim 1 was objected to, and claims 2-13 were rejected under 35 U.S.C. §112, second paragraph. Claims 1-4 and 7-15 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1, 3-9, 21 and 22 of copending application 10/628290. Claims 1-2, 5-6 and 9 were rejected under 35 U.S.C. §102(b) as being anticipated by Clingempeel; and claims 1-15 were rejected under 35 U.S.C. §102(e) as being anticipated by Gustafson (U.S. 6,451,480). These grounds of objection and rejection are respectfully traversed for the following reasons.

Claim 1 has been amended to expressly recite “portable electronic appliance,” which defines “PEA” and also provides the appropriate antecedent basis for the “portable electronic appliance” recited in claim 2. Reconsideration of the claim objection and rejection under §112, second paragraph is therefore respectfully requested.

With respect to the provisional double patenting rejection, filed herewith is a Terminal Disclaimer that disclaims any term beyond the term of a patent that might issue from copending application 10/628,290. Withdrawal of the provisional double patenting rejection is accordingly requested.

Regarding the rejection based on Clingempeel, applicants note that claim 1 of the present application has been amended to recite that the claimed battery includes an anode, cathode, and electrolyte, wherein the electrolyte includes alkali metal salt. Dependent claim 15 specifies that the alkali metal salt is a lithium salt. While Clingempeel discloses a lithium battery that includes an electrolyte that contains lithium metal, Clingempeel actually is absent any disclosure of the use of a lithium salt in his electrolyte. In other words, Clingempeel fails to disclose at least one key limitation recited in amended claim 1 and, as such, cannot anticipate amended claim 1 or any claims dependent thereon. It appears the Examiner should agree with this assessment of Clingempeel in light of the fact that this reference was not used to reject original claims 14 and 15 in the first instance. Withdrawal of this ground of rejection is therefore respectfully urged.

Regarding the rejection based on Gustafson '480, applicants note that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP 2131.

In this case, Gustafson '480 does not meet this level of required disclosure. While Gustafson '480 discloses anodes and cathodes with certain weight percentages of solvent, the reference, in fact, does not disclose any weight percentages of solvent for the electrolyte itself. The Examiner has argued that "the interfaces of the anode-separator and the cathode-separator satisfy the claimed requirement of furnishing the electrolyte separator...and the specified amount of solvent." See page 9 of the Office Action. This argument, as best understood by the applicants in view of the lack of express disclosure of Gustafson '480, must be an "inherency" argument -- that the solvent weight percentage in the electrolyte would necessarily result from

the construction of Gustafson's anode, cathode and separator stack. However, neither the Examiner nor one skilled in the art, based on the disclosure of Gustafson '480, can be positively certain that the claimed weight percentages of solvent (10-40%, 15-30%, and 20-25%) would necessarily be present in the electrolyte. At best, it might be possible that these weight percentages would be present, but it is not a certainty, which is required in a rejection based on inherency. As noted by the Federal Circuit, "the mere fact that a certain thing *may result* from a given set of circumstances is insufficient to prove anticipation." *Electro Medical Systems, S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994) (emphasis in the original).

Since the claimed solvent weight percentages in the electrolyte do not inherently flow from structures disclosed by Gustafson '480, applicants respectfully urge the Examiner to reconsider and withdraw the anticipation rejection based on Gustafson '480.

In view of the foregoing all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone applicants' undersigned representative at the number listed below.

Serial No.: 10/628,403
Art Unit: 2682

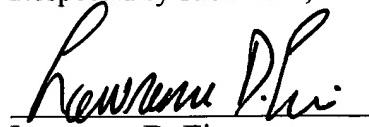
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Attachments: Terminal Disclaimer

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